REMARKS

The following Request For Withdrawal Of Finality Of Office Action and Request for Reconsideration are being submitted in response to the Final Office Action issued on October 13, 2004 (Paper No. unknown), in connection with the above captioned patent application, and is being filed within the three-month shortened statutory period set for a response to the Office Action.

Applicants note that the Examiner has misidentified the status of the claims on the Summary sheet of the Office Action. In particular, although the Examiner states that claims 280-299 are pending, in fact claims 106-299 are pending, with claims 106-279 being withdrawn from consideration as being directed to a non-elected invention.

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

The Examiner has made the present Office Action final for the reason that Applicants' amendment necessitated a new grounds of rejection. However, Applicants respectfully submit that in fact the new grounds of rejection was not in fact made in response to any amendment by Applicants, and accordingly request that the finality of the present Office Action be withdrawn.

In particular, Applicants respectfully point out that the amendments made to the claims of the Application consist entirely of the Preliminary Amendment concurrent with the filing of the application on January 13, 2000, in which claims 1-105 were canceled in favor of new claims 106-279, an amendment on June 16, 2003 in which claim 173 was amended to include a feature that was requested by the Examiner to place such claim in

condition for allowance (a decryption key (KD) being encrypted in a particular manner), and an amendment on December 8, 2003 in which claims 280-299 were added.

At present, only claims 280-299 are under consideration, and such claims have never been amended or previously examined in a substantive manner. Moreover, such claims as written do not include the feature that was added to claim 173 by amendment. Accordingly, such claims 280-299 do not in any way constitute claims that have been amended in response to any prior rejection such as would allow the Examiner to make the present Office Action final in view of a new grounds of rejection being applied to such claims.

Moreover, Applicants respectfully point out that such claims 280-299 have been previously identified by the Examiner as being a separate invention (Group III in the Office Action mailed April 26, 2004) and accordingly such claims cannot be said to be other already-rejected claims in a re-worked form. Finally, Applicants respectfully point out that finally rejecting such claims 280-299 on a first examination thereof is a clear violation of PTO policy that allows Applicants at least one chance to address a claim rejection before the rejection is made final. See MPEP 706.07(a).

For all of the aforementioned reasons, then, Applicants again respectfully submit that the finality of the present Office Action is premature. As a result, Applicants respectfully request that such finality be withdrawn.

REQUEST FOR RECONSIDERATON

In the present Office Action, the Examiner has rejected claims 280, 283, 284, 288, 290, 291, 293, 294, and 298 under 35 U.S.C. § 102(e) as being anticipated by Krishnan et al. (U.S. Patent No. 6,073,124). Applicants respectfully traverse the § 102(e) rejection.

Applicants respectfully note that in the present Office Action, the Examiner provides a Response to Amendment at page 1. However, such Response cannot be with regard to the pending claims 280-299 inasmuch as such claims have never been amended after being added to the Application, and are directed to a different invention according to the Examiner. Moreover, Applicants respectfully submit that they and the undersigned cannot understand the substance of such Response inasmuch as the Response is replete with idiomatic and grammatical shortcomings that effectively render such Response unintelligible.

That said, independent claim 280 as submitted and in its present un-amended format recites a method for a server to provide to a client computer a digital license of one or more rights to render digital content, where the digital content is encrypted with a decryption key. In the method, the server receives from the client computer a license request, where the license request contains a key identifier that identifies the decryption key. In response to the request, the server generates a license response including a digital rights license, the decryption key identified by the key identifier, and at least one server certificate to be used by the client computer to validate the license response. Thereafter, the server transmits the license response to the client computer.

Independent claim 290 recites subject matter similar to that of claim 280 except that in response to the request, the server transmits a license response to the client computer, where the license response includes a digital rights license, the decryption key

identified by the key identifier, and at least one server certificate to be used by the client computer to validate the license response. That is, claim 290 does not require that the server itself generate the license response.

Thus, the invention as recited in claims 280 and 290 involves delivering a license to a client computer in response to receiving a request for same with a key identifier identifying a decryption key for corresponding content. Based on such key identifier, the decryption key itself may be produced and included with the license. For example, and as set forth in the present Application, the key identifier may be applied as an input to an algorithm by which the decryption key is produced.

The Krishnan reference discloses a system for facilitating digital commerce wherein a client obtains content from a content server and then obtains an electronic license certificate (ELC) or license from a licensing broker / server. In such Krishnan reference at column 14, lines 35-39 that a DeveloperID field and a SecretKey field are used to create a symmetric key to decode the Krishnan license as generated by the licensing broker. However, such a symmetric key is not a decryption key for decrypting encrypted content, as is required by claims 280 and 290.

Moreover, although the Krishnan reference does disclose that the content thereof can be encrypted, such reference is entirely silent with regard to any disclosure that such content can be decrypted according to a decryption key that is identified by a key identifier, as is required by claims 280 and 290, or that such a key identifier is received from a requesting client as part of a request for a license, as is also required by claims 280 and 290. Instead, the Krishnan reference teaches that the license as decrypted exposes code that can

then be combined with the Krishnan content to result in a complete executable that may be executed.

Applicants note that the Examiner in setting forth the present section 102 rejection states in numerous instances that certain things are 'obvious'. However, Applicants respectfully point out that any conclusion of obviousness is incorrect in connection with such section 102 rejection inasmuch as section 102 is concerned with anticipation and not obviousness.

Applicants also note that the Examiner in setting forth the present section 102 rejection states in numerous instances that certain things are 'inherent'. However, MPEP 2112 makes it clear that inherency can be applied to establish anticipation only when it is clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities, or by mere wishful thinking. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Thus, Applicants respectfully request that the Examiner support each instance where subject matter recited in a claims is asserted to be 'inherent' in the relevant arts with extrinsic evidence supporting such assertion. Otherwise, Applicants respectfully request that the Examiner withdraw such assertion.

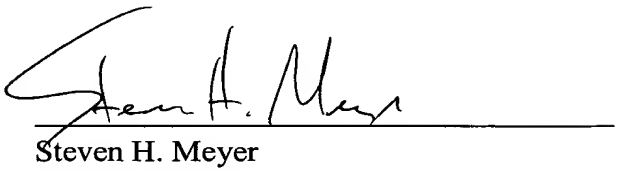
Thus, for all of the aforementioned reasons, Applicants respectfully submit that the Krishnan reference cannot be applied to anticipate independent claims 280 or 290 or any dependent claims depending therefrom. As a result, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection.

In the present Office Action, the Examiner has also rejected claims 282 and 292 under 35 U.S.C. § 103(a) as being obvious over the Krishnan reference, and claims 285-287, 289. 295-297, and 299 under 35 U.S.C. § 103(a) as being obvious over the Krishnan reference in view of Stefik (U.S. Patent No. 5,715,403). Applicants respectfully traverse the § 103(a) rejections.

Applicants respectfully submit that since independent claims 280 and 290 have been shown to be unanticipated and are non-obvious, then so too must all claims depending therefrom be unanticipated and non-obvious at least by their dependencies. As a result, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejections.

In view of the foregoing, Applicants respectfully submit that the present Application including claims 280-299 is in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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